IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION

NOTICE OF MOTION NO.1292 OF 2005
IN
SUIT NO.1110 OF 2005

Taparia Tools Limited Plaintiff
Mumbai.

versus

1. Ambica Overseas,
Jalandar City.

2. Balaji Tools Centre,
Mumbai. Defendants

Mr.Salil Shah i/by Gajaria & Co. for plaintiff.

Mr.Virag Tulzapurkar with Bhagwati Trivedi for defendants.

CORAM : S.C.DHARMADHIKARI, J.

DATE : 11th August 2005

PC :

1. The plaintiffs have filed present suit claiming perpetual injunction in the following terms :-

(a) that the Defendants by themselves, their servants and agents be restrained by a perpetual order and injunction of this Hon'ble Court from in any manner

applying or causing to be applied in relation to wrenches and pliers or any other goods contained in Class 01 of the Fourth Schedule of the Designs Act, 1911 (now repealed and substituted by the Designs Act 2000) and Rules thereunder, the designs described in Exhibits C and E to the Plaint or any other design which is identical to or deceptively similar to or a fraudulent imitation of the Plaintiffs registered designs nos.167097 and 178415 in Class 01 described in Exhibit A-1 and B-1 to the plaint, so as to pirate the Plaintiffs registered design nos.167097 and 178415 in Class 01 or from doing anything with a view to enable the Plaintiffs design nos.167097 and 178415 from being pirated;

(B) that the Defendants by themselves, their servants and agents be restrained by a perpetual order and injunction restraining the Defendants from in any manner applying or causing to be applied to wrenches and pliers or any other goods the designs described in Exhibits-A-1 and B-1 to the plaint, or any other design or designs which are identical to or deceptively similar or a fraudulent imitation of the Plaintiffs designs described in Exhibit-A-1 and B-1 to the Plaint so as to pass off their good as and for the goods of the Plaintiff."

I am not concerned with other reliefs in the plaint at this stage. Suffice it to state that they are for payment of damages and for a decree to deliver up to the plaintiffs goods referred to in the aforesaid prayers.

2. Notice of Motion, naturally, is for temporary injunction in the aforesaid terms. Additionally, appointment of Court Receiver is also prayed.

3. Mr.Shah - learned counsel appearing for the plaintiffs invites my attention to the averments in the plaint. He states that the basis of the claim in the suit is that plaintiff carries on business of manufacturing and marketing of various types of Hand Tools. Defendant no.1 is in similar business. Defendant no.2 is a trader or stockist of Hand Tools.

4. Mr.Shah submits that in March 1994, the plaintiff conceived a novel design of an adjustable Wrench. He submits that a considerable time, effort and money has been spent to develop the design of Wrench. The novel and important feature of this adjustable Wrench is it’s shape, configuration and the scale marking on one of the faces of the Wrench. With a view to protect the unique design and novelty of this product, an application was made for registration of the same on or about 28th March 1994. Mr.Shah submits that the design has been accepted and registered and in support of this submission, he relies upon Annexure-A, A-1 and A-2 to the plaint.

5. Similarly, in or around 1998-99, submits

Mr.Shah, that plaintiff conceived and developed a Plier having handles covered with sleeves of a novel shape and configuration. This was also after a considerable effort. With a view to protect this design of the Plier with the Sleeves, plaintiff made an application on 5th January 1999 and that application was accepted. In other words, both designs have been accepted and insofar as Plier is concerned, registration certificate is at Annexure-B-1. Mr.Shah submits that novelty in respect of the designs resides in the aspects which have been illustrated in the Certificate of Registration pertaining thereto. The registration is valid and subsisting.

6. Mr.Shah submits that by virtue of these registration certificates, the plaintiff has acquired status as registred proprietor of the copyright in the said designs. Plaintiff is, thus, entitled exclusively to apply the said designs to the products/goods referred to above. The plaintiff has manufactured the goods since April 1994 and January 1999 respectively. Mr.Shah then invites my attention to the Certificates of Excellence received by the plaintiff. He also invites my attention to the fact that plaintiff has acquired a name in the

hand-tool market. He invites my attention to the sales figures set out in para 9 and the advertisement expenditure in para 10.

7. He submits that in or around May 2003 the plaintiff learnt that first defendant was manufacturing and selling, through defendant no.2, in Mumbai, adjustable Wrench which was a fraudulent and obvious imitation of the plaintiff's registered design. He invites my attention to the fact that the plaintiff has not consented to the first defendant applying their design to the Wrenches. Thus, the first defendant has committed and continues to commit infringement and piracy of the plaintiff's registered designs. He invites my attention to the photographs of first defendant's goods.

8. Mr.Shah invites my attention to paras 13 to 15 of the plaint and states that despite notice to cease and desist from infringing the registered designs, the plaintiffs were surprised that the first defendant did not do so. Instead, it replied through its advocate and falsely contended that the Wrench's features shown in the plaintiff's registration certificate, were in existence and available on a commercial scale

prior to 1994.

9. Mr.Shah contends that the goods disappeared from the market for some time but in January 2005 not only the Wrenches resurfaced but first defendant also started manufacturing and selling Pliers with identical design as that of plaintiff.

10. It is in these circumstances that the plaintiff has approached this Court and claimed the aforesaid perpetual injunction. Mr.Shah submits that the traders and public associate the design with novel shapes and configurations as that of the plaintiffs and when the same are being infringed and the defendant no.1 is trying to pass off and/or enable others to pass off their designs as that of the plaintiff, then a prima facie case is made out. Balance of convenience is also in favour of the plaintiff inasmuch as plaintiff is in the trade since 1994. Plaintiff will suffer irreparable harm, loss and injury if interim reliefs as prayed are not granted.

11. In support of his submissions Mr.Shah relies upon an order passed by me in Notice of Motion

No.2135 of 2002 in Suit No.2583 of 2002. He submits that this order was passed in identical facts and circumstances. He submits that first defendant even in this case have not been able to make good their case that the shape and configuration in respect of plaintiff's designs is common to the trade and has been used by several manufacturers prior to 1994.

12. On the other hand, Mr.Tulzapurkar appearing for first defendant submits that the suit is filed with a view to harass and pressurise the first defendant who is a formidable competitor of the plaintiff. He submits that this is not a case where any original or unique design conceived of by the plaintiff, needs to be protected. He submits that there is nothing original nor novel in respect of the designs in question. He submits that several other manufacturers of hand-tools have been using the said designs and their products have identical shape and configuration and such products have been in the market for decades together. He submits that Designs Act is not intended to protect parties like the plaintiff herein.

13. He submits that the Notice of Motion needs

to be dismissed because plaintiff has suppressed material facts from this Court. He submits that both articles are not designs as defined in clause (d) of Section 2 of Designs Act, 2000. In fact, the designs are not registrable at all. He invites my attention to paras 3 to 7 of the affidavit in reply and submits that the first defendant is equally reputed and well-known in the trade circles and even internationally. The sales are on higher scale than that of the plaintiff. The first defendant is also an award winner. It has got ISO-2002 status. Mr.Tulzapurkar further submits that the plaintiff is not right in contending that the shape or configuration is novel and original inasmuch as first defendant has been manufacturing the Wrenches and Pliers since 2002 continuously without interruption. He submits that there are several persons/ manufacturers in the market who have been selling the said Wrenches and Pliers prior to the plaintiff. He has contended that apart from the annexures to the affidavit in reply there is enough material of such prior user.

14. Mr.Tulzapurkar contends that first defendant has not discontinued the manufacture and sale of

the goods and it is false to suggest that it had stopped doing so after receipt of notice from plaintiff. Mr.Tulzapurkar in this behalf relies upon paras 11 and 12 of the affidavit in reply. He also relies upon para 16 and contends that no person can have monopoly over the scale marking on a Wrench. He has taken me through the certificates produced by the plaintiff on record. He submits that the entire purpose of the application is to bring the business of first defendant to a stand still. Mr.Tulzapurkar has contended that the Registration of Design Nos.167097 and 178415 ought to be cancelled under sections 19(1) (b), (c), (d) and Section 2(d) of the Designs Act. Section 22 (3) of the Designs Act, 2000 expressly provides that in any suit or proceeding relating to a case of piracy of registered design it would be open for a party being sued to avail of all the grounds which are available for cancellation of a registered design. This is a valid defence to the proceedings. The plaintiffs design registration bearing Nos.167097 and 178415 are liable to be cancelled as per sections 19(b), (c), (d) and (3) of the Designs Act, 2000. The plaintiffs have obtained the registration of the Designs of the Wrench and Pliers dishonestly and cannot take

advantage of their dishonest act and prevent others from manufacturing the said Wrenches and Pliers. As stated hereinabove the registration of these designs are liable to be removed and cancelled and the defendants are taking appropriate steps in that behalf. Lastly, Mr.Tulzapurkar urges that present suit has been filed on 3rd March 2005 and the notice to cease and desist was given on 12th May 2003. The delay in filing of this suit is thus fatal.

15. Mr.Shah invites my attention to the rejoinder and contends that materials produced are nothing but an extract from the information available on Inter-net. The veracity of the inter net content is suspect and cannot be relied upon as gospel truth. Mr.Shah has invited my attention to para 9 of the affidavit in rejoinder in this behalf.

16. With the assistance of both sides I have perused the plaint, annexures thereto and affidavits filed on record. I have also perused the provisions of Designs Act, 2000. The first question that arises for my consideration is whether any prima facie case is made out by the plaintiff.

17. The Designs Act as originally enacted and now amended, has enlarged the scope of definition of terms "Article" and "Design". It has introduced the definition of the term "Original". The term "Original" as defined in Section 2(g) reads thus :-

> "(g) ‘original’, in relation to a design, means originating from the author of such design and includes the cases which though old in themselves yet are new in their application."

A bare perusal of this definition indicates that in relation to a design the word "original" means originating from the author of such design and thereafter the definition includes cases which though old themselves yet are new in their application. The term "Design" is defined in section 2(d) and the term "Article" is defined in Section 2(a). Since some argument has been advanced by Mr.Tulzapurkar on the basis of definition of the term "Article" it is necessary to reproduce the same :-

> ‘article’ means any article of manufacture and any substance, artificial, or partly artificial and partly natural; and includes any part of

> an article capable of being made and sold separately."

18. Mr.Tulzapurkar's submission is that the Act prohibits registration of certain designs. That prohibition is to be found in Section 4. Any design which is not new or original and which has been disclosed to the public anywhere in India or in any other country by publication in tangible form or by use or in any other way prior to the filing date, or where applicable, the priority date of the application for registration, or is not significantly distinguishable from known designs or combination of known designs shall not be registered. He submits that Section 22 of the Act, by virtue of sub section (3) thereof, provides that in any suit or proceeding for relief u/s 22(2), every ground on which registration of a design may be cancelled u/s 19, shall be available as a ground of defence. Mr.Tulzapurkar states that in section 19(1), while setting out grounds on which registration of a design can be cancelled, the Legislature has taken care to include a design which is not new or original or something which is not a design u/s 2(d) of the Act. He submits that the registration itself in favour of the plaintiff is liable to be cancelled. Since this is the basis

of the submissions by both sides, I will have to necessarily find out as to whether the design of plaintiff is new or original.

19. For that purpose, I must find out as to what is the registered design of the plaintiff. The first product is Wrench. Insofar as Wrench is concerned, the certificate that is annexed at Annexure-A-1 states that novelty resides in the shape and configuration of the Wrench as illustrated. Mr.Tulzapurkar states that a perusal of this statement in the certificate itself would show that there is absolutely no novelty insofar as the scale marking is concerned. The novelty itself is in the shape and configuration of the Wrench. Therefore, there is no question of the scale being typical, leave alone original or novel and associated with the plaintiff. He submits that the statement in para 3 of the plaint that the most important novel feature of the plaintiff's adjustable wrench is it's shape, configuration and scale marking on one of it's faces, is palpably and ex-facie false. The same does not confirm to the registration certificate and the novelty mentioned therein. There is much substance in the criticism of Mr.Tulzapurkar.

20. The first defendant has in the affidavit filed in reply specifically contended that there is no novelty in respect of the design or in the shape and configuration of the wrench. It is contended by him that all wrenches in the market prior to the plaintiff's registration and thereafter have similar shapes, configuration and scale. Hence assuming without admitting that novelty resides in the scale marking as well, even that marking is not novel or original. There is no novelty residing in the wrench insofar as the shape and configuration. Mr.Tulzapurkar sought leave to file an affidavit to bring on record the documents to support the plea of prior publication of wrench. That apart, it is the case of the first defendant that the designs were available in India and other countries prior to filing of the application for registration of the plaintiff's designs. This is a material fact which is suppressed by the plaintiff from this Court.

21. I am, prima facie, of the view that plaintiff's design of Wrench is published in India and other countries prior to the date of registration by them. Although, Mr.Shah would

contend that the statement in the affidavit in reply to the aforesaid effect is not supported by any materials, in my view, a perusal of exhibits to the affidavit in reply and the further reply would go to show that the designs of Wrenches have been published in India prior to the registration in favour of plaintiffs. The exhibits are not mere extracts of information available on inter-net. There is an extract of the certificate of ISI.. The information may be available on inter-net/web-site but when the same contains statements about parties using such designs from 1984-85, it cannot be brushed aside straight away. The truth and veracity of such statements in addition to the assertions on affidavit will have to be decided at the Trial. Even the plaintiff could have filed further affidavit but that opportunity is not availed off. Further, several wrenches available in the market were produced for my perusal. When I saw each one of them it is clear to the naked eye that their shape and configuration is common to that of the plaintiff. Even the scale marking appears to be common. Thus, insofar as the scale marking is concerned, there does not appear to be any novelty. Even as regards the shape and configuration of the wrench, there is ample

material produced by the first defendant to prima facie negative the pleas of plaintiff.

22. Since defendant no.1 appears to be in the market for a sufficient length of time and has also a sizeable turn over, the statement on affidavit that the shape and configuration of the wrench is predominantly dictated by the functionality of the product rather than by any features of aesthetic value cannot be brushed aside.

23. Insofar as Plier is concerned, the plaintiff’s case is that novelty resides in the portions marked "B", "C" and "D" on the sheets annexed to the Registration Certificate Exhibit-B-1. In other words, the novelty resides in the shape and configuration particularly in this marked portions. Mr.Shah submits that as far as Plier is concerned, what is material are the sleeves. He submits that design is unique. He submits that the protruding portion on the sleeve is peculiar and associated with the plaintiff alone.

24. This statement is refuted by Mr.Tulzapurkar and he relies upon affidavit filed by first

defendant and annexures thereto. First defendant has categorically stated that the design of the Plier having handles covered with sleeves is not of a novel shape or configuration. The design of the Plier is not new or original. There is no novelty in respect of said design or in the shape and configuration of the sleeves of the Plier. The registration is falsely obtained and defendant no.1 is taking steps to have the same cancelled. That apart, it is contended that several persons have been manufacturing and selling similar sleeve pliers. Plaintiffs have merely copied the designs existed and published prior to the registration.

25. Mr.Tulzapurkar has alternately contended that there cannot be any novelty insofar as the sleeves on the pliers are concerned. In his submission, the same cannot be said to be articles at all. The word "Article" is defined in Section 2(a) means any article of manufacture and any substance, artificial or partly artificial and partly natural. In his submission, for the inclusive portion to be applied it is necessary that part of an article should be capable of being made and sold separately.

26. After having seen the article namely Plier photocopies whereof are annexed to the certificate and also produced for examination, it is difficult at this prima facie stage to hold that the sleeve of the plier is capable of being sold separately. In my view, the controversy being whether the novelty and originality resides in the sleeves of the plier or not, it is not necessary to decide this wider question. If I am satisfied that the sleeves also are known to the trade being common in their application to similar products manufactured before the registration in favour of the plaintiff, then it is not necessary to decide the larger question posed for my consideration by Mr.Tulzapurkar. Reliance being placed on the fact that even pliers with this same design are in public domain atleast since 1985 and that plea being prima facie substantiated by the further affidavit, then it is clear that plaintiffs have failed to make out a prima facie case even insofar as the novelty or originality of the design in respect of the plier. My observations with regard to the annexures to the affidavit are already there. What holds good for wrenches applies for pliers as well. The same observations need not be

repeated.

27. Now, what remains is the reliance placed on my order in Notice of Motion No.2135 of 2002 in Suit No.2583 of 2002. It is true that the said order is in a suit instituted by the plaintiff for identical reliefs. The articles were also identical. However, it is relevant to note that in that matter when a compilation was tendered to support the argument that the designs were common to the trade, it was pointed out that in the compilation produced by the defendants before me, the designs were different from the registered designs. Secondly, although the relevant provisions of the Act have been noticed by me, I have in that case after examining the articles found that the defendants could not satisfy me that the wrenches have been common to the trade and manufactured by them prior to the dates of registration in question. In para 15 of my order this is what is stated :-

> "15. The only submission of defendants is that there is nothing novel and the articles with their shapes and designs are part of common trade. It may be true that there are several manufacturers of these articles. However, the uniqueness insofar as adjustable wrenches in the plaintiffs designs is the scale mark. Shri Chitnis is unable to point out

anything from the compilation of documents which would show that adjustable wrenches with scale mark are being manufactured and marketed by the entities referred to in these documents. Shri Chitnis has not been able to controvert the submission of the plaintiffs to the effect that the novelty and uniqueness in the shape and configuration of the design is specifically mentioned in the registration certificate. It is pertinent to note that the statement on oath made by the defendant is that certificate of registration of design is not conclusive of the fact that the design is original. The defendants have contended that plaintiffs are not proprietors of new or original design and the design registered is pre-existing common type. These submissions have to be corroborated and supported by independent material. Further, there is no substance in the contention of the defendants that they have been manufacturing, marketing and selling machine tools for the past many years. This submission is based upon a confusing and contradictory stand in the affidavit. In the affidavit it is stated that in or about October 2000, defendants introduced in the market adjustable wrenches and pliers with sleeves. This statement is vague. The sales figures tendered across the bar are also not of any substantial nature. For the accounting period 1st April 2001 to 31st March 2002, the sales figures for the pliers and adjustable wrenches are Rs.1,38,567.90 and Rs.10,88,650.26 respectively. However, these figures are mentioned in the Advocate’s letter. There are no supporting affidavits of any dealer. Defendants have submitted that the plaintiffs are not aware of hard realities about hand tool manufacturers and the plaintiffs should not, because of money power, attempt to suffocate genuine competition in business. In my view, apart from this statement, defendants acknowledge the fact that the plaintiffs are in the market for considerable length of time and have built up a reputation and goodwill of their own. That there is

> no novelty in the designs but they are part of common trade is a fact which should be substantiated by the defendants."

On the other hand, the decision noted by me in my order namely 1999(1)-BCR-239 would apply to the facts of present case. There, sales figures and other materials were produced. There, this Court had noticed that even prior to the registration of the design of the plaintiffs, the goods/articles were sold in the market with same design. Cogent and satisfactory material in support of the contentions about availability of the articles/goods in the market, was furnished as in the present case. In the light of the same, my order in the above notice of motion will not apply to the facts of this case.

28. In the circumstances, the plaintiffs have failed to make out a prima facie case. Notice of Motion is dismissed. However, there will be no order as to costs. The observations made by me as aforesaid are only for the purposes of disposal of Notice of Motion. They will not influence the Court at the trial.

(S.C.DHARMADHIKARI, J.)